

# A new dawn for Argentina

**Santiago R. O'Connor of O'Connor & Power examines recent changes to Argentinian trademark law that have brought decades of stagnation to an end.**

The purpose of this article is to briefly indicate how the different amendments introduced to Argentine Trademark Law No. 22,362 since the month of January 2018, initiated by Decree No. 27/2018, have impacted on everyday trademark protection and practice.

It is important to underline that Trademark Law No. 22,362 ("TML") was issued in the year 1981. More than 35 years passed until Decree No. 27/2018 introduced the first important changes to the "TML", updating the same to reflect modern standards of international trademark practice.

Argentina has a strong and healthy tradition in the protection of trademark rights in Latin America; however, many of its prosecution procedures differed from the ones applied by other countries, and this led to Argentina becoming isolated and "old" vis a vis worldwide trends.

Changes were finally triggered in early 2018 with the introduction of a new opposition system by which the parties involved, once officially notified, have three months to reach an amicable agreement to obtain the withdrawal of an opposition.

If no agreement is reached, an administrative procedure is initiated which will finally be decided by the Argentine Trademark Office



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("TMO") with the possibility of filing an appeal through a court action with the Federal Courts.

During this opposition procedure, the opposing party needs to ratify its objection by adding arguments and paying a substantial additional official fee.

The latter has meant that many physical persons and companies which used to file groundless oppositions or objections with speculative purposes have refrained from doing so, mainly due to the economic implications and costs of maintaining these kinds of objections.

The reduced quantity of useless oppositions creates the benefit of a more dynamic and agile procedure, which for the time being is not visible, due to the backlog of the TMO in the handling of the new opposition system.

In the prior opposition system, objections which were not solved in an amicable manner by the parties necessarily fell into federal court actions, which caused high costs and long-term decisions.

This prior opposition procedure system was unique in Latin America and observed with bemusement by trademark applicants who could not believe that a federal court action needed to be filed to obtain the removal of an opposition, when the same should be solved administratively by the TMO.

At this time, however, we need to wait to determine the nature and grounds of these kinds of decisions to be issued by the TMO.

Nullifications and Non-Use Cancellation Actions are also now decided by the TMO.

Unfortunately, there is presently a considerable delay and backlog before the TMO in the handling and prosecution of these items.

The new obligation of the filing of a Mid-Term Declaration of Use ("MTDU") within the fifth and the sixth year of the granting of a trademark has caused confusion among trademark holders.

The TML now establishes two types of declarations of use. On one side is the Declaration of Use ("DJU") indicating that a trademark has been used during the last five years prior to the



renewal of a trademark; and on the other, the new "MTDU" for the maintenance of a trademark registration.

When filing a trademark renewal, it is mandatory to file both types of declarations - that is for the "DJU" as well as the "MTDU".

For the moment there are no sanctions or consequences for not having filed the "MTDU" in that, to the contrary of what the lack of its filing causes in other jurisdictions, for example the USA, the only derivation in Argentina is that the TMO shall not allow the renewal of a trademark unless the "MTDU" has also been submitted.

We shall have to wait and monitor to establish if the TMO shall introduce new sanctions for the non-filing of this new document.

A major advance is the mandatory electronic filing of all documents with the TMO, as well as the payment of the official fees by electronic means.

It is also now possible to renew trademarks within a six-month grace period, which once seemed impossible to apply in Argentina, even though the majority of Latin American countries have already adopted the same for many years.

However, this grace period brings the uncertainty of determining if a mark which is an obstacle for an application has been renewed or not until the grace period has ended.

Argentina is not a member of the Singapore Trademark Law Treaty. Therefore, there is no multi-class application system and in order to obtain trademark protection it is necessary to file a separate and single trademark application per class.

“ Changes were finally triggered in early 2018. ”

Finally, it is now necessary to indicate the specific goods and services upon the filing of a trademark application.

The new amendments have not introduced, for the time being, any reference to the issuance of TMO office actions regarding the registrability (or not) of a mark and citation of antecedents which is left at the end of the registration procedure, when it should be applied at the beginning of the procedure.

This situation emphasizes the importance of conducting trademark searches before trademark filing, so as to avoid an annoying surprise at the end of the registration procedure.

We trust that all of these recent amendments shall optimize and grant even more efficiency to the protection of trademarks in Argentina - one of the most active and outstanding countries in South America, a beloved darling in the region, due to its high influence of European and American culture and background.

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## Résumé

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Santiago R. O'Connor is the managing partner of O'Connor & Power, a leading IP practice based in Buenos Aires. Santiago specializes in all aspects of intellectual property, principally trademarks, advising domestic and foreign companies on local and international IP law, prosecution and litigation in Argentina and Latin America. He advises Forbes and Fortune 500 companies in a variety of industries, such as technology and telecommunications, pharmaceuticals, luxury goods agriculture, food and wine, and entertainment.

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